

S/N 09/965,405
Art Unit 3627
Atty Dkt 10013329-1

REMARKS

Claims 1-23 were pending in the application prior to this response.

Claims 1-23 remain in the application unchanged by this response.

Reexamination and reconsideration are requested.

S/N 09/965,405
Art Unit 3627
Atty Dkt 10013329-1

I. Rejection of Claims 1-12 under 35 U.S.C. §103(a)

Claims 1-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Webber, Jr. (U.S. 6,167,378). Reexamination and reconsideration are requested.

Applicants' claim 1 recites the following:

A method for a first organization to do business comprising:
entering into a contractual relationship with a second organization;
authorizing said second organization to take an order from a customer, said order comprising at least one of:
products not produced by said first organization, and services not provided by said first organization; receiving payment directly from said customer as a payment for said order taken by said second organization; requiring an organization other than said first organization to ship products not produced by said first organization to said customer; requiring an organization other than said first organization to provide services to said customer.

The Examiner states the following in paragraph 2 of the Office action:

With regard to claim 1, Webber discloses a method for a first organization (direct marketer in example, col. 12 line 43+) to do business that includes entering into a contractual relationship with a second organization (winery), authorizing the second organization to take an order from a customer, wherein the order is for products or services not produced by the first organization

The Examiner, thus, takes the position that applicants' recited "first organization" and "second organization" read on the direct marketer and the

S/N 09/965,405
Art Unit 3627
Atty Dkt 10013329-1

winery, respectively, discussed in the Webber, Jr. example.

Applicant's claim 1, however, recites, for example, the following:

**authorizing said second organization to take an order from
a customer**

In the Webber, Jr. example, the winery does not take orders from customers. Instead, orders are taken by the direct marketer. The relevant portion of Webber, Jr. reads as follows:

EXAMPLE

Assume for the purpose of illustration the conventional business of selling wine directly to customers, that is, direct marketing. The winery or its broker contracts with the direct marketer to sell the winery's wine. **The final retail customer buys the wine from the direct marketer** and the wine is to be shipped directly to the customer. **The direct marketer collects payment from the customer** by credit card. The direct marketer negotiates the credit card payment with its bank and deposits the funds in its bank account. The seller transmits sale data to system.

(Webber, Jr., col. 12, lines 42-52, emphasis added)

Accordingly, in Webber, Jr., orders are taken by the direct marketer. Thus, the second organization (the winery in the Webber, Jr. example) is not authorized "to take an order from a customer" as recited in claim 1.

For at least the reasons above, Webber, Jr. fails to meet all of the limitations of claim 1. Applicants, thus, respectfully assert that the Examiner's rejection of claim 1 is improper and should be withdrawn.

In paragraph 4 of the final Office action, the Examiner responds to the above arguments as follows:

Page 4 of 11

S/N 09/965,405
Art Unit 3627
Atty Dkt 10013329-1

Applicant's arguments filed November 7, 2003 have been fully considered but they are not persuasive. Applicant argues that the Webber reference does not disclose "authorizing said second organization to take an order from a customer," however, the examiner disagrees and stands by the rejection. According to the system of Webber, the first organization (marketer) receives orders from customers and authorizes the second organization (winery) to fulfill the orders (col. 13, line 4+).

The Examiner, thus, takes the position that applicants' claim limitations are met because Webber discloses that the second organization is authorized to *fulfill* orders. As noted above, however, applicants' claim 1 recites the following limitation:

**authorizing said second organization to take an order from
a customer**

Claim 1, thus, requires authorizing the second organization to *take an order*. Taking an order is clearly different from *fulfilling an order*. Accordingly, even assuming, arguendo, that Webber makes the disclosure asserted by the Examiner (i.e., that the second organization is authorized to fulfill orders), the above claim 1 limitation is not met.

The Examiner further states the following in paragraph 4 of the final Office action:

Furthermore, it would be obvious to one skilled in the art that customers could place orders directly with the producer (winery) and bypass the marketer to save money and time as this is well-known in the field.

The Examiner, thus, apparently takes the position that, even if Webber does not disclose all of applicants' claim limitations, claim 1 would, nevertheless, be obvious. Applicants respectfully assert, however, that the

S/N 09/965,405
Art Unit 3627
Atty Dkt 10013329-1

limitations of claim 1 are not within the knowledge of a person of ordinary skill in the art and the Examiner has submitted no evidence to the contrary.

Accordingly, there is absolutely nothing in the file history of this prosecution to support the Examiner's position. There must be something in the teachings of cited references to suggest to an individual skilled in the art that a claimed invention would be obvious. *W. L. Gore and Associates v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure." *In re Dow Chemical Co.*, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988).

The Court of Appeals for the Federal Circuit has also addressed this issue in at least one more recent case. See, *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001). Although the following comments from this opinion focus on the Board of Appeals, applicants assert that the logic embraced by these comments would be equally applicable to examiners:

... the deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is "basic knowledge" or "common sense" to one of ordinary skill in the art.... This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support.... With respect to core factual findings in a determination of patentability ... the Board cannot simply reach conclusions based on its own understanding or experience - or in its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.

Id., at 1697

Thus, it is not proper for an examiner to assert that certain claim limitations are "well-known" and, therefore, obvious, without providing evidentiary support in the record.

For the reasons set forth above, applicants respectfully assert that a *prima facie* case of obviousness has not been established and that,

FEB-10-2004 15:49

303 297 2266

303 297 2266

P.10

S/N 09/965,405
Art Unit 3627
Atty Dkt 10013329-1

accordingly, claim 1 should be allowed.

Claims 2-13 are allowable at least as depending from allowable base
claim 1.

Page 7 of 11

S/N 09/965,405
Art Unit 3627
Atty Dkt 10013329-1

II. Rejection of Claims 13-23 under 35 U.S.C. §103(a)

Claims 13-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Webber, Jr. (U.S. 6,167,378). Reexamination and reconsideration are requested.

Claims 13-17

Applicants' claim 13 recites the following:

A method for a first organization to do business comprising:
requiring a second organization to take an order for sales items on behalf of the first organization;

In response to a determination that the order includes a product distributed by a third organization sending an order for that product to the third organization;

requiring the third organization to ship the product directly to a customer's address.

Claim 13, thus, recites "**requiring a second organization to take an order for sales items**". Accordingly, claim 13 is allowable for at least the reasons advanced above with respect to claim 1.

Claims 14-17 are allowable at least as depending from allowable base claim 13.

Claim 18

Applicants' claim 18 recites the following:

Page 8 of 11

S/N 09/965,405
Art Unit 3627
Atty Dkt 10013329-1

A method for a first organization to do business comprising:
requiring a second organization to take an order for sales items on behalf of the first organization;
in response to a determination that the order includes a product distributed by a third organization sending an order for that product to the third organization;
requiring the third organization to notify the first organization when the order exceeds a predetermined credit limit of the second organization.

Claim 18; thus, recites "**requiring a second organization to take an order for sales items**". Accordingly, claim 18 is allowable for at least the reasons advanced above with respect to claim 1.

Claims 19-23

Applicants' claim 19, recites the following:

A method for a first organization to do business comprising:
in response to a determination that services in a service order taken by a second organization on behalf of the first organization is incomplete determining whether the service order includes support services; and
determining a billing strategy based upon whether or not the service order includes support services.

Claim 19, thus, recites "**a service order taken by a second organization**". Accordingly, claim 19 is allowable for at least the reasons

FEB-10-2004 15:50

303 297 2266

303 297 2266

P.13

S/N 09/965,405
Art Unit 3627
Atty Dkt 10013329-1

advanced above with respect to claim 1.

Claims 20-23 are allowable at least as depending from allowable base
claim 19.

Page 10 of 11

S/N 09/965,405
Art Unit 3627
Atty Dkt 10013329-1

For the reasons advanced above, applicants respectfully assert that all of the claims are in condition for allowance.

Respectfully submitted,
KLAAS, LAW, O'MEARA & MALKIN, P.C.

By _____

Michael A. Goodwin, Reg. No. 32,697
KLAAS, LAW, O'MEARA & MALKIN, P.C.
1999 Broadway, Suite 2225
Denver, CO 80202
Telephone: (303) 298-9888
Fax: (303) 297-2266
Date: February 19, 2004